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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/744,612   | 03/09/2001  | Sami Uskela          | 617-010120-US       | 1625             |
| 2512   | 7590        | 04/28/2005           | EXAMINER            |                  |
| PERMAN & GREEN<br>425 POST ROAD<br>FAIRFIELD, CT 06824 |             |                      | ZEWDU, MELESS NMN   |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2683                |                  |
| DATE MAILED: 04/28/2005                                |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/744,612

Applicant(s)

USKELA, SAMI

Examiner

Meless N Zewdu

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 9-13 is/are rejected.
- 7) ☒ Claim(s) 6 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. This action is in response to the communication file on 12/27/04.
2. Claim 14 had previously been cancelled.
3. Claim 15 has been added new.
4. Claims 1-13 and 15 are pending in this action.
5. The Sunay et al. reference (US 6,353,626 B1) has been withdrawn from further consideration in response to applicant's argument.
6. The objection to the drawings has been withdrawn in response to the replacement figures submitted.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 7, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. (US 5,940,762).

**Regarding claim 1:** Lee discloses a method for performing handover of a mobile station communicating in a first call via a first network to communication in a second call via a second network (see abstract; figs. 2A-2D; col. 7, lines 19-67), comprising:

generating a request for handover (abstract; col. 5, lines 49-65; col. 6, lines 33-59).

establishing the second call between the first network and the mobile station via the second network (abstract; figs. 2A-2D; col. 8, lines 29-58, particularly lines 50-58). The prior art of intersystem soft handoff shows that a second intersystem link is connected while the first intersystem link is still active.

transferring data communication between the mobile station and the first network from the first call to the second call (see abstract; col. 7, lines 40-67).

**Regarding claim 2:** Lee discloses the step of releasing the first call after data communication between the mobile station and the first network has been transferred from the first call to the second call (see col. 8, lines 59-62). Terminating a call properly transferred is same as releasing the call.

**Regarding claim 4:** Lee discloses a method wherein the first network generates the request for handover (see col. 6, lines 33-59).

**Regarding claim 7:** Lee discloses a method wherein the first network originates the second call (see col. 6, lines 33-59).

**As per claim 12:** Lee discloses a method wherein the first and second networks are cellular telephone networks (see abstract; col. 4, lines 18-40).

**As per claim 13:** Lee discloses a method wherein the mobile station is capable of communicating by radio with the first and second networks (see abstract; col. 5, lines 13-30; col. 6, lines 34-59).

Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee as applied to claim 1 above, and further in view of Duran et al. (Duran) (US 6,115,608).

**Regarding claim 3:** but, Lee does not explicitly teach about a method wherein the mobile station generates the request for handover, as claimed by applicant. However, in a related field of endeavor, -- "Intersystem Handover Method and Apparatus" --, Duran teaches that a mobile station is capable of initiating intersystem handover/handoff (see col. 3, lines 33-53; col. 7, lines 45-51; col. 10, lines 18-67). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Lee with that of Duran for the advantage of the mobile station to monitor/detect and store the signal quality of nearby stations to make a decision as to when and to which BTS to handover.

**Regarding claim 5:** Duran, teaches a method wherein the mobile station originates the second call (see col. 3, lines 33-53; col. 7, lines 45-51; col. 10, lines 18-67). Since, the key question here is a mobile originating handoff request, the feature of claim 5 is similar to the feature of claim 3. Hence, claim 5 is rejected on the same ground and motivation as claim 3. **Explanation:** In Lee the mobile unit communicates with different systems simultaneously in intersystem soft handoff. In Duran, the mobile unit is shown to have initiated intersystem handoff. When the references are combined, the mobile unit would be able to initiate intersystem handoff via any of the BTS in either of the systems involved in the intersystem handoff. In other words, the key feature is the

Art Unit: 2683

capability of the system wherein the mobile is enabled to communicate simultaneously with a first and second systems.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee as applied to claim 1 above, and further in view of Byrne et al. (Byrne) (US 5,659,598).

**As per claim 9:** Lee does not explicitly teach about a method wherein the geographical coverage of the second network is greater than that of the first network, as claimed by applicant. However, in a related field of endeavor, Byrne teaches about a handover procedure from a cordless base station (cordless telephone system) to a mobile radio-telephone system, wherein the second system/network covers greater geographical area than that of the first (see abstract). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Lee's reference with the teaching of Byrne for the advantage of enabling users to handover from a cordless telephone system (small area) to a mobile radio system (larger area).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee as applied to claim 1 above, and further in view of Fernandez et al. (Fernandez) (US 2001/0022615 A1).

**As per claim 10:** but, Lee does not explicitly teach about a method wherein the first network is an IMT-200 network, as claimed by applicant. However, in a related field of endeavor, Fernandez teaches that IMT-2000 is a standard air interface for mobile/wireless radio communication equipment, like cellular (see page 4, paragraph 0042). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make a wireless/mobile radio equipment/system IMT-

Art Unit: 2683

2000 air interface enabled since it is a standard to be met by any entity requiring the service provided by the standard.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee as applied to claim 1 above, and further in view of Menich et al. (Menich) (US 6,449,305 B1).

**As per claim 11:** Lee does not explicitly teach/disclose about a method wherein the second network is a PDC network, as claimed by applicant. However, in a related field of endeavor, Menich teaches about a handoff technique between different networks that include CDMA, AMPS and PDC (see col. 4, line 65-col. 5, line 10). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Lee's reference with the teaching of Menich for the advantage of providing mobile stations handoff services between networks that employ different protocols (see col. 35-48).

### ***Response to Arguments***

In response to applicant's argument that the reference issued to Sunay et al. (US 6,353,626 B1) belongs to the same assignee, examiner has removed the reference from the prior art of record.

***Allowable Subject Matter***

Claim 15 is allowed.

The following is an examiner's statement of reasons for allowance:

**As per claim 15:** although claim 15 is drawn new, it is the original claim 1 modified with the combination of previously objected original claim 6. The prior art of record does not teach or fairly suggest the features or method steps recited in the modified claim 15, for performing handover of a mobile station.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim 6 and consequently claim 8 are objected to as being dependent upon a rejected base claim, but would be allowable if (claim 6) rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N Zewdu whose telephone number is (703) 306-5418. The examiner can normally be reached on 8:30 am to 5:00 pm..



Art Unit: 2683

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Meless Zewdu

M. Z.

Examiner

17 June 2004.

  
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